

Requirement under 37 C.F.R. § 1.105

The Examiner indicated that Applicants are required under 37 C.F.R. § 1.105 to provide certain information that the Examiner has determined to be reasonably necessary for the examination of the present application. (See Paper No. 20, page 2.) In particular, the Examiner asserted that

Applicant has listed approximately 22 co-pending applications which are drawn to related subject matter (IDS of paper #19, filed 25 September 2002). Applicants are required to [1] supply a tabulated summary of the pending claims in each of the co-pending applications and [2] the relationship of the instant SEQ ID NO:1 with each of the other "related" sequence from the co-pending applications (such as with a sequence alignment), with [3] a brief summary of the clear line of demarcation which will be maintained between the claims in the co-pending applications as required by MPEP § 822 and 37 CFR 1.78(b)

(Paper No. 20, page 2.)

1. Request for Pending Claims

Applicants note that the First Supplemental Information Disclosure Statement filed September 25, 2002, (Paper No. 19) directed the Examiner's attention to eight co-pending applications containing related technical subject matter. Accordingly, Applicants will provide the requested information with regard to the eight co-pending applications referenced in Paper No. 19.¹ If the Examiner would like Applicants to provide the Examiner

¹Applicants note that U.S. Application Nos. 08/103,744, 08/104,507, 08/196,482, 08/196,363, 08/221,623, 08/275,627, 08/276,163, 08/345,704, 08/401,791, 08/799,180, 08/803,609, 08/803,610, 08/971,197, 08/975,985, 08/976,343, 08/985,366, 08/985,356, 09/076,897, and 09/078,617, listed in the Information Disclosure Statement filed May 4, 2000 (Paper No. 4), in the present application are no longer pending. Regarding the other three co-pending applications cited in Paper No. 4, Application No. 09/023,082 issued as U.S. Patent No. 6,077,692, Application No. 09/218,444 issued

with additional information related to any other co-pending applications, Applicants invite the Examiner to provide the Applicants with the application numbers of such applications.

In response to the Examiner's request that Applicants supply a summary of the pending claims in each of the co-pending applications, Applicants submit herewith copies of the currently pending claims for each of the following co-pending applications:

Application No. 09/248,998 ["the '998 application"], filed February 12, 1999;

Application No. 09/585,541 ["the '541 application"], filed June 2, 2000;

Application No. 09/610,651 ["the '651 application"], filed June 30, 2000;

Application No. 09/853,666 ["the '666 application"], filed May 14, 2001 and published as Publication No. 2002/0016295 A1 on February 7, 2002;

Application No. 09/912,292 ["the '292 application"], filed July 26, 2001;

Application No. 10/035,212 ["the '212 application"], filed January 4, 2002;

Application No. 10/075,446 ["the '446 application"], filed February 15, 2002; and

Application No. 10/194,443 ["the '443 application"], filed July 12, 2002.

Applicants note that the claims submitted herewith are the claims that are presently pending in the above-referenced co-pending applications, and that the claims are subject to amendment during the course of examination in each of the applications.

2. Request for Relationship of SEQ ID NO:1 with Related Sequence

The Examiner further requested that Applicants indicate "the relationship of the instant SEQ ID NO:1 with each of the other 'related' sequence[s] from the co-pending

as U.S. Patent No. 6,238,888, and Application No. 09/248,998 is one of the eight co-pending applications cited in the First Supplemental Information Disclosure Statement filed September 25, 2002 (Paper No. 19).

applications (such as with a sequence alignment)." (Paper No. 20, page 2.) As an initial matter, Applicants note that the nucleotide sequence of SEQ ID NO:1 is the same in the present application and the above-referenced co-pending applications, except for the '292 application. In addition, Applicants note that the amino acid sequence of SEQ ID NO:2 of the co-pending applications and the present application is the same, except for the '292 application, and shows an amino acid sequence of 208 amino acid residues which encodes a keratinocyte growth factor (KGF-2) polypeptide. Thus, as between the present application and the '998 application, the '541 application, the '651 application, the '666 application, the '212 application, the '446 application, and the '443 application, no sequence alignment is necessary to enable proper examination.

With respect to the '292 application, Applicants wish to bring the Examiner's attention that the pending claims for the '292 application are directed neither to SEQ ID NO:40589 nor to KGF-2-related subject matter. As the attached claim set for the '292 application shows, SEQ ID NO:40589 is not being claimed. Thus, as between the present application and the '292 application, no sequence alignment is necessary to enable proper examination.

Moreover, regarding this specific request for information, Applicants note that an authorized representative of Applicants contacted Thurman K. Page, a Supervisory Patent Examiner in Art Unit 1615.² During this conversation, it was indicated by Mr. Page that the "relationship of the instant SEQ ID NO:1 with each of the other 'related' sequence[s] from

²Thurman K. Page was responsible, along with Bruce Campbell (SPE Art Unit 1661), for the development and implementation of Rule 105.

the co-pending applications (such as with a sequence alignment)," need not be submitted to the PTO.

3. *Request for Brief Summary of the Clear Line of Demarcation*

In addition, the Examiner requested that Applicants supply "a brief summary of the clear line of demarcation which will be maintained between the claims in the co-pending applications as required by MPEP § 822 and 37 CFR 1.78(b)." (Paper No. 20, page 2.) Rule 78(b) provides that "[w]here two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application." 37 C.F.R. § 1.78(b).

As such, absent evidence from the Examiner that the present claims and the claims of another co-pending application are conflicting, Applicants submit that the issue of whether or not the elimination of such claims from all but one application may be required is moot. Applicants have provided a copy of the pending claims in each of the above-referenced co-pending applications for assisting the Examiner in making this determination.³

³Applicants note that an authorized representative of Applicants contacted Thurman K. Page with respect to this specific request for information as well. During this conversation, it was indicated by Mr. Page that while Applicants need to acknowledge Rule 78(b), the submission of a copy of the co-pending claims is sufficient.